

Application No. 10/693,730

Reply to Office Action

REMARKS

Reconsideration of the pending application is respectfully requested in view of the foregoing amendments and the following remarks.

Status of the Application

Claims 1-16 are currently pending. Certain claims have been amended to more clearly indicate the subject matter Applicants claim as their invention. No new matter has been introduced into the application by way of these amendments.

Summary of the Office Action

The Office Action opens by objecting to claims 6, 8, 11, 13 and 14 due to an alleged lack of antecedent basis for the limitation "aqueous fountain medium."

The Action continues by rejecting claims 1-16 under 35 U.S.C. § 112, first and second paragraphs, as failing to comply with the written description requirement, the enablement requirement, and the definiteness requirement. Specifically, the specification purportedly does not describe a fountain medium being 100% water and further comprising a solution having at least one moiety. It is further unclear how the fountain medium may be 100% water and further comprise at least one moiety.

Claim 1 is rejected as anticipated under 35 U.S.C. § 102(e) by U.S. Published Patent Application US2005/0053867 ("Delabastita").

Claims 1, 2 and 4 are rejected as anticipated 35 U.S.C. § 102(a) by U.S. Patent 5,163,999 ("Uchida").

Claims 3 and 5-9 are rejected under 35 U.S.C. § 103(a) as unpatentable over Uchida in view of U.S. Published Patent Application US2002/0077450 ("Kirchmeyer"). Uchida is said to teach the invention except for the intrinsically conductive polymer being selected from a particular group. Kirchmeyer allegedly teaches an intrinsically conductive polymer selected from the group absent in Uchida, with the asserted combination being justified on the basis that one would want to utilize components that dissolve quickly in solvents.

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Claims 4, 11, 13, 15 and 16 are rejected under 35 U.S.C. § 103(a) as obvious over Uchida in view of U.S. Patent 6,632,472 ("Louwet"). Uchida is said to teach the invention except for the intrinsically conductive polymer being selected from a particular group. Louwet allegedly teaches an intrinsically conductive polymer selected from the group absent in Uchida, with the asserted combination being justified on the basis that one would want to reduce the amount of energy required to dissolve the ingredients, as taught by Louwet.

Claim 10 is rejected under 35 U.S.C. § 103(a) as obvious over Uchida in view of Kirchmeyer and further in view of U.S. Patent 6,827,435 ("Domoto"). The combination of Uchida and Kirchmeyer purportedly teaches the claimed invention except for heating the receiving medium, within 10 minutes after printing, to a certain temperature range. Domoto is said to teach this heating limitation, the combination being justified on the basis that one practicing Uchida would heat the receiving medium as taught by Domoto in order to prevent the printed images from smearing.

Claim 12 is rejected under 35 U.S.C. § 103(a) as obvious over Uchida in view of Louwet and further in view of Domoto. The combination of Uchida and Louwet purportedly teaches the claimed invention except for heating the receiving medium, within 10 minutes after printing, to a certain temperature range. Domoto is said to teach this heating limitation, the combination being justified on the basis that one practicing Uchida would heat the receiving medium as taught by Domoto in order to prevent the printed images from smearing.

Discussion

In response to the lack of antecedent basis objection, Applicants have amended claims 6, 8, 11 and 13-15. As a result, a proper antecedent basis for the limitation "said aqueous fountain medium" is now provided. Applicants respectfully request withdrawal of this objection.

The Section 112 rejections of claims 1-16 are addressed by an amendment to claim 1, wherein this claim now reads "a fountain comprising a fountain medium comprising between 50% by weight and 100% by weight of water, said fountain further comprising as a solution or dispersion in said fountain medium at least one moiety" This passage, as amended, clearly distinguishes between the fountain on the one hand and the composition of the

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fountain on the other hand, and indicates that fountain comprises a fountain medium and a moiety present as a solution or dispersion in the fountain medium. The fountain medium is understood by those skilled in the art as a liquid in which other ingredients of the fountain are dissolved or dispersed. For example, at page 7, lines 17-19 of the application, it is stated that "[t]he term aqueous medium means a medium containing water and water-miscible organic solvents containing between 50% by weight of water and 100% by weight of water." Dyes and pigments are disclosed in the application as components that are relatively soluble or insoluble in the medium, as intrinsically conductive polymers may also be incorporated into the aqueous fountain medium as a conventional aqueous dispersion. *See, e.g., page 7, lines 32-34 and page 9, lines 22-27.* Further, claim 1 as filed discloses, *inter alia*, a process for the offset printing of a receiving medium comprising the steps of applying a printing ink to a printing plate and wetting the printing plate with an aqueous fountain medium containing a solution or a dispersion containing at least one moiety having at least coloring, pH-indicating, whitening, fluorescent, phosphorescent, X-ray phosphor or conductive properties. It is submitted that, as presented, the claims are also not indefinite. As claims 1 and 2-16 now meet all the requirements of the first and second paragraphs of Section 112, Applicants respectfully request withdrawal of all rejections entered under this section.

Turning to the substantive rejections, the Office Action alleges that claim 1 is anticipated by Delabastita. However, nowhere in Delabastita is it disclosed that the dampening liquid (medium) contains, or even should contain, "at least one moiety having at least pH-indicating, whitening, fluorescent, phosphorescent, X-ray phosphor or conductive properties." *See, e.g., Delabastita, at [0003], wherein the composition of the dampening liquid is not disclosed or suggested.* For this reason, Delabastita does not disclose the invention as claimed, and further fails to teach or suggest the claimed invention; Delabastita fails to identify (or even suggest) any specific components that are (or should be) included in its dampening liquid. As a consequence, withdrawal of the rejection based on Delabastita is appropriate, and is respectfully requested.

The Office Action further rejects claims 1, 2 and 14 over Uchida. Contrary to the assertion in the Office Action, Uchida fails to disclose the invention as claimed. For example, nowhere in Uchida is there disclosed a medium containing "at least one moiety

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having at least pH-indicating, whitening, fluorescent, phosphorescent, X-ray phosphor or conductive properties." For example, Uchida discloses pH-adjusting components, but does not disclose or suggest the inclusion of pH-indicating components as required by the claims. Further, the assertion in the Office Action that Uchida's disclosure of water as a conductor does not equate to the claimed medium containing "at least one moiety having at least . . . conductive properties." In the claimed invention, at least one moiety having conductive properties in addition to the medium itself is recited, and Uchida's disclosure and teaching of using water alone does not meet this limitation. Water is rendered conductive by the inclusion of conductive species therein; Uchida fails to disclose the inclusion of any moiety having conductive properties, e.g., intrinsically conductive polymers. Moreover, none of the other components required in the claims is disclosed or taught by Uchida, e.g., a medium containing at least one moiety having at least whitening, fluorescent, phosphorescent, X-ray phosphor or conductive properties.

It is clear that Uchida fails to unambiguously disclose or suggest each and every limitation recited in the pending claims. For this reason, claims 1, 2 and 14 (as well as all of the other pending claims) are patentable over Uchida.

Claims 3 and 5-9 are rejected as purportedly being obvious over Uchida in view of Kirchmeyer. It is respectfully submitted that this rejection fails from the outset, as Uchida does not disclose or suggest the use of an intrinsically conductive polymer in its dampening solution. More generally, and as previously noted, Uchida fails to disclose the presence of any conductive species in its dampening solution.

Further, there is no basis for the combination in the references themselves. Kirchmeyer is directed to process for the preparation of polythiophenes that are soluble or dispersible in anhydrous or low-water-content systems, and uses of these polythiophenes. There is no mention of polythiophenes in Uchida. As a consequence, one skilled in the art would find no motivation or incentive in either reference for combining the teaching of Kirchmeyer with Uchida to yield any beneficial effect. Withdrawal of this rejection is, therefore, proper and respectfully solicited.

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Claims 4, 11, 13, 15 and 16 are rejected as obvious over Uchida in view of Louwet. Again, the proposed combination fails form the outset because Uchida does not disclose or motivate one skilled in the art to use an intrinsically conductive polymer in the dampening solution. As before, Uchida fails to disclose or suggest the use of a conductive species in a dampening solution. Louwet fails to address this deficiency, and the combination fails on this basis. Further, there is no basis for making the asserted combination because the problems addressed by Louwet (*see, e.g., Louwet paragraphs [0015-0018]*), are different than those that need to be solved by Uchida. For these reasons, withdrawal of the rejection is respectfully requested.

Claim 10 is rejected as obvious over Uchida in view of Kirchmeyer and Domoto. At the outset, Applicants submit that there is no motivation for making the combination of Uchida and Kirchmeyer (as described above). Further, and assuming *arguendo* the combination is proper, Kirchmeyer does not address the deficiencies of Uchida (as discussed above), and thus does not render the claim obvious even with the addition of Domoto. Domoto in contrast desires to provide a system and process that can involve heating, cooling, drying, remoisturizing which avoid artifacts in image drying where speed, safety and spatial uniformity are all required. First, Applicants note there is no basis for combining the references, because Domoto's problem is different than that facing Kirchmeyer and Uchida. Second, it is improper to utilize hindsight to select only those portions of a reference's teachings necessary to reconstruct Applicants' claimed invention. In other words, there is no basis, even if one assumes the combination is proper, to select only one aspect of Domoto and, somehow, combine this into the teachings provided by the asserted Uchida/Kirchmeyer combination. For these reasons, withdrawal of this rejection is respectfully requested.

Claim 12 is rejected as obvious over Uchida in view of Louwet and Domoto. At the outset, Applicants submit that there is no motivation for making the combination of Uchida and Louwet (as described above). Further, and assuming *arguendo* the combination is proper, Louwet does not address the deficiencies of Uchida (as discussed above), and thus does not render the claim obvious even with the addition of Domoto. Domoto in contrast desires to provide a system and process that can involve heating, cooling, drying, remoisturizing which avoid artifacts in image drying where speed, safety and spatial

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uniformity are all required. First, Applicants note there is no basis for combining the references, because Domoto's problem is different than that facing Louwet and Uchida. Second, it is improper to utilize hindsight to select only those portions of a reference's teachings necessary to reconstruct Applicants' claimed invention. In other words, there is no basis, even if one assumes the combination is proper, to select only one aspect of Domoto and, somehow, combine this into the teachings provided by the asserted Uchida/Louwet combination. For these reasons, withdrawal of this rejection is respectfully requested.

Conclusion

Applicants believe the application is in proper condition for allowance, the examiner is respectfully requested to pass the application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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